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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,703	10/20/2003	Robert Scarano	436.006	2842

7590 10/12/2005

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EXAMINER

HARPER, V PAUL

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/687,703	Applicant(s) SCARANO ET AL.	
	Examiner V. Paul Harper	Art Unit 2654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 23 September 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER

UPA

[Signature]

Response

Claim Rejections - 35 USC § 112

1. The 112 2nd rejections are withdrawn as being satisfied.

Response to Arguments

2. Applicant's arguments filed 9/23/05 have been fully considered but they are not persuasive.

3. Applicant asserts on page 10:

Clements mentions metadata as an unsatisfactory basis for searching distance learning modules. Thus, instead of commending the use of metadata, the article **teaches away** from the use of metadata for searching. *Certainly, there is no suggestion that metadata be used to select audio segments that are then subject to being searched.* Since, as previously urged and repeated above, Glowny's description of reassembling a call stored in segments neither teaches nor suggests the use of using metadata to select some subset of audio segments that are then subject to being searched, the applied art, even if combined would fail to defeat patentability of the pending claims. (Italics added)

Glowny et al. teach the use of metadata to locate a particular recording and give an example where a call is located to resolve a disputed transaction (¶'s [0003], [0004] and [0044]). The implication here being that once the call is located it will be listened to in order to resolve the dispute (i.e., a manual audio search performed to locate the desired information). Clements teaches the phonetic searching of learning modules

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(streaming audio, CD, ...; i.e. recordings; abstract). Clements is clearly implying that the search occurs within a [previously] restricted domain (e.g. a course on a CD). In this sense, Clements is not teaching away from the use of metadata, but rather he is necessarily using it to restrict the phonetic search.

When Clements mentions metadata as an unsatisfactory basis for searching distance learning modules he is discussing the two techniques (metadata/phonetic search) applied at the same level of search, not the use of the metadata to limit the phonetic search as described above (and in the rejection).

4. Applicant further asserts on page 12

Further, applicant again urges that the references are not properly combinable under 35 U.S.C. § 103(a) for lack of motivation for making the asserted combination. To the contrary, as Clements dismisses the use of metadata, instead suggesting the use of his phonetic searching technique, one skilled in the art would be taught NOT to use metadata and thereby NOT make the asserted combination. That is, not only does the applied art fail to provide the requisite motivation for making the asserted modification but instead teaches away from the combination. (Italics added)

See §3, above. In the rejections of claims 1 and 16, the motivation given for the combination is the saving of time during searching (Glowny ¶'s [0002] and [0003]). From Glowny's perspective, once a recording is found the techniques of Clements can aid in the rapid location of the desired information within the file. From Clements' perspective, the application of the metadata before the phonetic search greatly reduces the search space, and hence reduces the search time. Both argue for the efficiency of

their respective techniques (Glowny for getting to a recording and Clements for searching a recording) and the combination further improves efficiency.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Paul Harper whose telephone number is (571) 272-7605. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571) 272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/04/2005

V. Paul Harper
Patent Examiner
Art Unit 2654